

REMARKS:

Claims 1-28 are currently pending in the application.

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,823,495 to *Vedula*, et al. ("*Vedula*").

The Applicant respectfully submits that all of the Applicant's arguments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections.

REJECTION UNDER 35 U.S.C. § 103:

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over *Vedula*.

The Applicant respectfully submits that *Vedula* fails to disclose, teach, or suggest each and every element of Claims 1-28. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-28 under 35 U.S.C. § 103(a) over *Vedula*.

***Vedula* Fails to Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to independent Claim 1, this claim recites:

An ***electronic commerce system for translating between one or more schemas***, the system comprising:
a ***global content directory*** for providing a plurality of buyers access to one or more seller databases; and
a ***schema translation tool*** coupled to the global content directory, the schema translation tool comprising:
a mapping module operable to:

receive information regarding a source schema and a target schema, the source and target schemas each comprising a taxonomy comprising a hierarchy of classes into which products may be categorized, wherein the target schema comprises a different taxonomy than the taxonomy of the source schema, at least the source schema further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes; and

associate one or more source classes of the source schema with one or more target classes of the target schema; and

an ontology generation module operable to generate a product ontology for each of the target classes based on the product ontologies of the associated source classes. (Emphasis added)

In addition, *Vedula* fails to disclose each and every limitation of independent Claims 9, 17, and 25-28.

The Applicant respectfully submits that *Vedula* fails to disclose, teach, or suggest independent Claim 1 limitations regarding an “**electronic commerce system for translating between one or more schemas**” and in particular *Vedula* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “**global content directory** for providing a plurality of buyers access to one or more seller databases”.

In particular, the Examiner equates the “**global content directory**” recited in independent Claim 1 with the “**Internet**” disclosed in *Vedula*. (19 September 2007 Office Action, Page 6). However, *the Internet disclosed in Vedula does not include, involve, or even relate to the global content directory*, as recited in independent Claim 1. (Column 1, Lines 24-29). For example, the Examiner relies on the “BACKGROUND OF THE INVENTION” of *Vedula*, to equate the “**global content directory**” recited in independent Claim 1 with the “**Internet**” disclosed in *Vedula*, however, the Applicant respectfully directs the Examiner’s attention to the “BACKGROUND OF THE INVENTION” portion of *Vedula* relied upon by the Examiner:

The **Internet is enabling businesses to develop new ways to facilitate efficient and automated interactions** between their own internal line of business, productivity and knowledge management applications, the applications used by their customers and trading

partners, and services provided by their commercial and corporate providers. (Column 1, Lines 24-29). (Emphasis Added).

The Applicant respectfully submits that the above cited portion of *Vedula* merely discloses that the Internet enables businesses to interact and that the Internet is merely a way to facilitate this interaction. In contrast, the "***global content directory***" recited in independent Claim 1 ***is coupled with a network, for example, the Internet, and provides a plurality of buyers access to one or more seller databases.*** Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Vedula* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Vedula*.

The Office Action Acknowledges that *Vedula* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Vedula* fails to disclose various limitations recited in independent Claim 1. Specifically the Examiner acknowledges that *Vedula* fails to teach "that the individual records are not specifically referring to products". (19 September 2007 Office Action, Page 3). However, the Examiner asserts that the acknowledged shortcomings in *Vedula* are "non-functional descriptive material". The Applicants respectfully traverse the Examiner's non-functional descriptive material assertion.

The Applicant respectfully submits that the Examiner has mischaracterized *Vedula*. For example, the Examiner asserts that "*Vedula* differs in that the individual records are not specifically referring to products, but are generic business documents records". (19 September 2007 Office Action, Page 3). In addition, the Examiner cites *Vedula* Column 3, Line 10 as support for this assertion. However, the Applicant respectfully directs the Examiner's attention to the cited portion of *Vedula*:

(e.g., representing an XML business document by an XML schema)

(Column 3, Line 10). The Applicant respectfully submits that it is clear that nowhere in Column 3, Line 10 does *Vedula* provide for "generic business documents records", as asserted by the Examiner. (19 September 2007 Office Action, Page 3). The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over *Vedula* According to the UPSTO Examination Guidelines

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on *Vedula*, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (KSR), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17-18, 148 USPQ 467 (1966)). As stated by the Supreme Court in KSR, "While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls." (KSR, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on *Vedula*. The Office Action merely states that “[f]orming the records to contain non-functional descriptive material, such as product information, would have been obvious to one of ordinary skill in the art”. (19 September 2007 Office Action, Page 3). The Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on *Vedula*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “**obviousness rejection should include**, either explicitly or implicitly in view of the prior art applied, **an indication of the level of ordinary skill.**” (Notice, 72 Fed. Reg. 57528

(Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) Vedula and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicant respectfully requests clarification as to ***why the difference(s) between Vedula and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting ***any*** rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "***the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.***" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on ***obviousness cannot be sustained by mere conclusory statements;*** instead, there ***must be some articulated reasoning with some rational underpinning to support the legal***

conclusion of obviousness.” (KSR, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Applicants respectfully submit that the ***Office Action fails to provide any articulation, let alone, clear articulation of the reasons why the Applicants claimed invention would have been obvious.*** For example, the ***Examiner has not adequately supported the selection of Vedula to render obvious the Applicant's claimed invention.*** The Examiner's unsupported conclusory statements that “[f]orming the records to contain non-functional descriptive material, such as product information, would have been obvious to one of ordinary skill in the art”, ***does not adequately provide clear articulation of the reasons why the Applicants claimed invention would have been obvious.*** (19 September 2007 Office Action, Page 3). In addition, the Examiner's unsupported conclusory statement ***fails to meet any of the Guidelines rationales*** to render obvious the Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on *Vedula*, the Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an explicit analysis of the rationale relied upon by the Examiner.

The Applicant's Claims are Patentable over the Proposed *Vedula*-Official-Notice Combination

The Applicant respectfully submits that, for at least the reasons set forth above, independent Claim 1 is considered patentably distinguishable over *Vedula*. With respect to independent Claims 9, 17, and 25-28 each of these claims are also considered patentably distinguishable over *Vedula*, for at least the reasons discussed above in connection with independent Claim 1.

Dependent Claims 2-8, 10-16, and 18-24 depend from independent Claim 1, 9, and 17, respectively. As mentioned above, each of independent Claims 1, 9, and 17 are considered patentably distinguishable over *Vedula* and the Examiner's Official Notice. Thus, dependent Claims 2-8, 10-16, and 18-24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-28 are not rendered obvious by the proposed combination of *Vedula* or the Examiner's Official Notice. The Applicant further respectfully submits that Claims 1-28 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1- 28 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-28 be allowed.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

17 December 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184